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| APPLICATION NO. | FILING DATE | FIRST NAMED INVENTOR | ATTORNEY DOCKET NO. | CONFIRMATION NO. |
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| 10/824,376 | 04/15/2004 | Carl Erik Hansen | 88265-7070 | 6618 |

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| EXAMINER | |
|---|---|
| PADEN, CAROLYN A | |

| ART UNIT | PAPER NUMBER |
|---|---|
| 1761 | |

DATE MAILED: 04/05/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

| Office Action Summary | Application No. | Applicant(s) | |
|---|---|---|---|
| | 10/824,376 | HANSEN ET AL. | |
| | Examiner | Art Unit | |
| | Carolyn A Paden | 1761 | |

*-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --*

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

1)☒ Responsive to communication(s) filed on *15 April 2004*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

4)☒ Claim(s) *1-20* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *1-20* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

**Application Papers**

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

12)☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☒ Some * c)☐ None of:

1.☒ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date _____.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

Claims 2-20 are provisionally rejected under 35 U.S.C. 101 as claiming the same invention as that of claims 1-25 of copending Application No. 10/819,180. This is a provisional double patenting rejection since the conflicting claims have not in fact been patented.

The co-pending application relates to manipulating the flavor of chocolate but also includes a reduced flavor chocolate. The flavor impact of the starting material is not alone seen to constitute an unobvious difference.

The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970);and, *In re Thorington,* 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

Claim 5 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a process using the amount of flavor

precursors in the flavor medium described on pages 5-6, does not reasonably provide enablement for any and all amounts and any and all mediums. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims. It is very well known in the art that different combinations of ingredients reacted together can produce different flavors and off-flavors. Applicant has limited his flavor attributes to those shown at page 4, last full paragraph.

Claim 7 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for a flavor made by the process described on pages 6-7 of the specification, does not reasonably provide enablement for the flavor resulting from any enzymatic hydrolysate of cocoa polysaccharide. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Claim 8 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for the flavor resulting for the treatment process shown on page 8 of the specification, does not reasonably provide

enablement for the flavor obtained from any acid and protease treatment. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

Claims 1, 3-14, 16-20 are rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for flavor attributes disclosed at page 4, last full paragraph, does not reasonably provide enablement for any and all flavor attributes. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to practice the invention commensurate in scope with these claims.

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

Claim 1-5 & 11-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ripper in view of Rusoff (2,835,590).

Ripper discloses the manufacture of chocolate liquor by treating the chocolate with a reduced pressure to remove the undesirable flavors of the

product. Then the chocolate is combined with sugar, cocoa butter, 1% flavoring and lecithin to prepare a chocolate product for molding. Claim 1 appears to differ from Ripper in the suggestion of adding flavor precursors that contain specific ingredients. Rusoff (2,835,590) teaches that combinations of peptides containing glycine or alanine with saccharide materials act to create chocolate flavor. At column 3, line 62 rhamnose is included as a suggested saccharide. At column 2, line 65 proline is included as a flavor enhancing agent. The concept of preparing the flavor ingredient in a fat-based medium is indirectly suggested because anhydrous conditions are required for the reaction at column 3, line 51-52. Thus it would have been obvious to one of ordinary skill in the art to utilize the flavor or Rusoff in the chocolate product of Ripper in order to enhance the chocolate impact of the product. It is appreciated that the specific flavors of claims 2 and 15 are not indicated but these flavor notes are well known descriptors of chocolate. It is also appreciated that "house flavor" and "asset utilization" and "cost reduction" and "recipe flexibility" are not mentioned but these features would be obvious variants of the basic Rusoff teachings. The specificity of these features would vary with the whims of

the market and taste of the consumer and are not seen to add patentable weight to the claims.

Claims 1- 4, 6 & 10-20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Ripper in view of Kleinert (3,769,030) or Watterson (5,676,993).

Ripper discloses the manufacture of chocolate liquor by treating the chocolate with a reduced pressure to remove the undesirable flavors of the product. Then the chocolate is combined with sugar, cocoa butter, 1% flavoring and lecithin to prepare a chocolate product for molding. The claims appear to differ from Ripper in the suggestion of adding flavor precursors that contain specific ingredients. Kleinert teaches the fabrication of milk flavors for use in chocolate by the development of the Maillard reaction products or carmelization reaction products (column 3, lines 48-59 & example 1. Although roasting is not specifically suggested in the reference, no unobvious or unexpected difference is seen between the heat treatment Kleinert and roasting. It would have been obvious to one of ordinary skill in the art to utilize the flavor of Kleinert in the chocolate of Ripper in order to enhance the caramel or maillard color/flavor of Ripper by using the fabricated flavors of Kleinert.

Similarly Watterson teaches that the Maillard reaction products of sugar and amino acids provide a way of enhancing the cocoa flavor of a fat matrix (see abstract). It would have been obvious to one of ordinary skill in the art to utilize the flavor of Watterson in the chocolate of Ripper in order to enhance the maillard flavor of Ripper by using the fabricated flavors of Watterson.

It is also appreciated that "house flavor" and "asset utilization" and "cost reduction" and "recipe flexibility" are not mentioned but these features would be obvious variants of the basic Rusoff teachings. The specificity of these features would vary with the whims of the market and taste of the consumer and are not seen to add patentable weight to the claims.

Claims 21-25 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

The specific definition of "house flavor" in claim 21 is unclear. Does applicant intend to mean "old sock aroma" or "moldy house" aroma? Does applicant mean "Hershey Town Flavor" and "Nestle Flavor"? If so, it is unclear to examiner as to what specific ingredients would constitute this flavor. Cancellation of this claim is suggested. Claims 22-25 refer to asset

utilization and cost reduction and recipe flexibility and it is unclear from the claims as to how these features can be achieved by the process steps set forth in the claims. Cancellation of these claims is suggested.

Claims 22-25 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter, which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention. The specification does not adequately set forth how the chocolate flavor process can lead to asset utilization, cost reduction and recipe flexibility. Cancellation of these claims is suggested.

Claims 6-8 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 6-8 appear to be improperly dependent from claim 1 because claim 1 is directed to a non cocoa flavor and dependent claims 6-8 are directed to a cocoa flavor. Clarification is requested.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

All of the Rusoff references are directed to the manufacture of cocoa flavor. US Patents 2,835,592-2,835,593 & 2,887,384-2,887,388 & 3,582,360 & 4,563,365 are directed to cocoa flavorings from non-cocoa sources. Each of these references could be combined with Ripper and utilized as references against at least claim 1 but have not been included in the office action in the expectation that applicant will amend the claims in order to avoid additional duplicative rejections.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Carolyn A Paden whose telephone number is (571) 272-1403. The examiner can normally be reached on Monday to Friday from 7 am to 3:30 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Milton Cano, can be reached on (571) 272-1398 or by dialing 571-272-1700. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is

available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Carolyn Paden 3-24-05
CAROLYN PADEN
PRIMARY EXAMINER 1761